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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,785	12/21/1999	TIMOTHY L. HUMPHREY	P64616US0	4093

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JACOBSON, PRICE, HOLMAN & STERN, PLLC
400 Seventh Street, N. W.
Washington, DC 20004

EXAMINER

SPOONER, LAMONT M

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 11/07/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,785

Applicant(s)

HUMPHREY ET AL.

Examiner

Lamont M Spooner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 16-19 and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 5-16, 20-30 and 35-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/21/1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group 1 in Paper No. 6 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 16 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Lawrence et al. (US Patent No. 6,289,342 filed 5/20/98).

As per **claims 1, 16 and 31**, Lawrence et al. discloses:

an automated method of designating text, taken from a set of citing documents, as reasons for citing (RFC) that are associated with respective citing instances of a cited document, the method comprising:

obtaining contexts of the citing instances in the respective citing documents, each context (C.9.lines 30-35-"This allows extraction of the context of the citations") including text that includes the citing instance and text that is near the citing instance(Fig 6 "very powerful [8], especially...");

analyzing the content of the contexts (C.9.lines 13, 14); and

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selecting from the citing instances' context, text that constitutes the RFC, based on the analyzed content of the contexts (Fig 6, C.9.lines 30-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2-4, 17-19 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al. in view of Pedersen et al. (US Patent No 5,638,543 filed June 3, 1993).

Lawrence et al. and Pedersen et al. are analogous art because they are both automated document manipulation methodology related.

As per **claims 2, 17, and 32** Lawrence discloses:

an automated method of designating text, taken from a set of citing documents, as reasons for citing (RFC) associated with respective citing instances of a cited document, the method comprising:

inputting text from the citing documents (C.9.lines 6, 7);

obtaining contexts of the citing instances in the respective citing documents, each context including: a sentence that includes the citing instance and at least one sentence that is near the citing instance (C.11.lines 33-37, Fig 6 "1. INTRODUCTION Second-order recurrent networks have proven to be very powerful [8], especially when

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trained using complete back propagation through time [1, 6, 14]. It has also been demonstrated by ...");

generating a content word list based on words that are in the citing documents' contexts (C.9.lines 9-11);

calculating, for the sentences in the citing documents' contexts, respective content scores that are based on the frequency counts of content words that are recited in the respective sentences (C.9.9-12); and

selecting, from the citing documents' contexts, the sentences that constitute the RFC (Fig 6 "It has also been demonstrated...").

Lawrence does not disclose:

dividing the citing documents' texts to define paragraphs, and dividing the paragraphs to define sentences;

selecting the sentences that constitute the RFC based on the calculated content scores.

However, as it is well known in the art, Pedersen et al. teaches:

dividing the documents' text texts to define paragraphs, and dividing the paragraphs to define sentences (C.3.lines 4-9).

selecting the sentences based on the calculated content scores (C.3.16-18).

Therefore it would have been obvious to a person skilled in the art to combine Lawrence et al. with Pedersen et al. The motivation for doing so would have been to select text based on scoring from the citing documents.

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As per **claims 3, 18 and 33** Lawrence et al. and Pedersen et al. disclose all of the limitations of claim 2 upon which claim 3 depends. Lawrence et al. further discloses:

the method, wherein the content word generating step includes;

generating the content word list based on words that are included in the contexts of at least two of the citing documents (C.8.12-16).

Therefore it would have been obvious to a person skilled in the art to combine Lawrence et al. with Pedersen et al. The motivation for doing so would have been to obtain the invention as specified in claim 2 as well as generate the content word list from at least two of the citing documents.

As per **claims 4, 19 and 34**, Lawrence et al. and Pedersen et al. disclose all of the limitations of claim 2 upon which claim 4 depends. Lawrence et al. further discloses:

the method, wherein the content word generating step includes:

generating the content word list based on words that are included both in the cited document itself and in the context of at least one citing document (C.9.28-31).

Therefore it would have been obvious to a person skilled in the art to combine Lawrence et al. with Pedersen et al. The motivation for doing so would have been to obtain the invention as specified in claim 2 as well as generate the content word list based on words included in the cited document and context of at least one citing document.

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Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lamont M Spooner whose telephone number is 703/305-8661. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Talivaldis Smits can be reached on 703/306-3011. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 receptionist whose telephone number is (703) 305-4700.

lms
10/22/03


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER